



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FEB 17 2006

In re Application of: Dimitrov et al. :
Appl. No.: 10/050,236 : DECISION ON PETITION
Filed: 15 January 2002 :
For: Method for Forming a MR Reader with Reduced :
Shield Topography and Low Parasitic Resistance :

This is responsive to the petition filed on September 13, 2005 by which petitioners' request supervisory review of:

- 1) the restriction requirement between Group I and Group II rendered in paper No. 20040907 mailed September 8, 2004, traversed by petitioners on October 6, 2004, made final by the Examiner in paper No. 20041227 mailed December 30, 2004, and again traversed on March 24, 2005; and
- 2) the further restriction requirement rendered in paper No. 20050606 mailed June 14, 2005, traversed by petitioners on August 15, 2005. The Examiner in Advisory Action, paper No. 08202005 mailed August 29, 2005, reaffirmed both requirements. This petition is considered pursuant to 37 CFR 1.144 and no fee is required.

The petition is granted.

With respect to the first restriction requirement, careful review of the application prosecution history reveals that the Examiner grouped claims 1-18 into Group I, claims 1-8 and Group II, claims 9-18 stating that each group is drawn to a method of making a magnetoresistive reader. The Examiner relied on section 806.05(d) of the MPEP to justify that these two groups are distinct.

The Examiner states "Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group II has separate utility within the process of making, such as the use of first and second photoresist layers, not required by Group I."

It is noted that the MPEP section 806.05(d) provides further guidance that "The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." Referring to Applicants' specification, the disclosed combination is a method best defined by the words of claim 9, which is defined by the Examiner as a subcombination. Nowhere in the specification is it found that the Group I claims, which are also defined by the Examiner as a subcombination, has other utility than in the disclosed combination. In other words, the specification never reveals that the steps of the inventive method could be practiced without the additional steps defined in claim 9 but not in claim 1. There is only one single

disclosed inventive method. MPEP section 806.03 states, "Where the claims of application define the same essential characteristics of a single disclosed embodiment [in this case, a method] of an invention, restriction should never be required. This is because the claims are not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition." The same is true for claims 1-18. Each claim defines the same single disclosed method varying in breadth or scope of definition. For these reasons, the restriction requirement between Groups I and II is improper and will be withdrawn.

With respect to the second restriction requirement, the Examiner now adds two more groups. The Examiner in the final Office action states:

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:

II. Claims 2-5, drawn to a magnetoresistive reader with first and second photoresist layers, classified in class 29, subclass 603.07.

III. Claims 21-32, drawn to forming a magnetoresistive reader without first and second photoresist layers, classified in class 29, subclass 603.12.

The inventions are distinct, each from the other because of the following reasons:

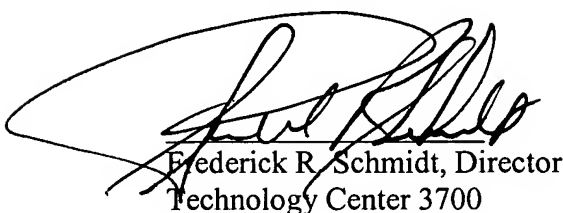
6. Inventions of Groups II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group III has separate utility such as removing the first and second photoresist layers, not required in Group II. Group II has separate utility in that the first and second photoresist layers are layers that are formed with the final product of the magnetoresistive reader. See MPEP § 806.05(d).

First of all, it is believed that the Examiner intended that claims 2-5 be drawn to the method of forming a magnetoresistive reader. In any event, the same analysis applied to claims 1-18 above, applies here. Each of these claims defines steps of the single disclosed method and not distinct subcombinations. For these reasons, the restriction requirement between Groups I and II is improper and will be withdrawn.

For the reasons outlined above, the restriction requirement promulgated and construed as being made final is not in accordance with proper Office procedure. Accordingly, the Office action rendered in paper No. 200506906 is hereby vacated.

The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3729 who will have the examiner promulgate an action on the merits of all presently pending claims not inconsistent with this Decision.

PETITION GRANTED



Frederick R. Schmidt, Director
Technology Center 3700

James A. Flight
HANLEY, FLIGHT & ZIMMERMAN, LLC
Suite 4220
20 North Wacker Drive
Chicago, Illinois 60606